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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Polle T. ZELLWEGER et al.

Group Art Unit: 2176

Application No.: 09/461,040

Examiner: M. Nguyen

Filed: December 15, 1999

Docket No.: 104323

For: SYSTEMS AND METHODS FOR ANNOTATING OBJECTS WHEN THE
ANNOTATION DEVICE DIFFERS FROM THE VIEWING DEVICE

RECEIVED

REQUEST FOR RECONSIDERATION

SEP 16 2003

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Technology Center 2100

Sir:

In reply to the August 13, 2003 Office Action, reconsideration of the rejection and
objections is respectfully requested in light of the following remarks.

Claims 1-37 are currently pending.

The Office Action rejects claims 1-37 under 35 U.S.C. §103(a) over U.S. Patent No.
6,173,287 to Eberman et al. (Eberman) in view of "A System View of Annotations" by
Cousins et al. (Cousins). This rejection is respectfully traversed.

Applicants respectfully submit that Cousins was never disclosed to the public until
some time in 2000. As such, it is not prior art to Applicants' December 15, 1999 application.
Although Applicants' February 7, 2000 Information Disclosure Statement lists a February 8,
1999 publication date, this date was erroneous. As evidence of a correct date, Applicants
submit an Internet research website listing of the Cousins article confirming a publication
year of 2000. In order for a reference to be qualified as prior art under 35 U.S.C. §102(a), the

subject matter of the reference must be known or used by others before the invention of the application by the Applicant for patent. Because all of the authors of the Cousins' reference are listed as co-inventors of this application, the subject matter in Cousins was not known or used "by others" prior to the filing date of this application. Moreover, as evidenced above, this article was not published until after the filing of Applicants' patent application. As admitted, the primary reference alone fails to anticipate or render obvious the claimed invention. Since the secondary reference to Cousins is not prior art, the Cousins' reference does not qualify as a prior art. Accordingly, Applicants respectfully submit that this rejection is improper and request withdrawal of this rejection.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-37 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Registration No. 27,075

Stephen P. Catlin
Registration No. 36,101

JAO:SPC/kzb

Attachment: Citation information on Cousins reference

Date: September 15, 2003

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